



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,133	07/25/2001	Michael John Dixon	LE9-00-083	6435

21972 7590 12/31/2002

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON, KY 40550-0999

EXAMINER

DONOVAN, LINCOLN D

ART UNIT PAPER NUMBER

2832

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,133

Applicant(s)

Dixon et al.

Examiner

Lincoln Donovan

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

Art Unit: 2832

DETAILED ACTION

Election/Restriction

1. Claim 11-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method of making a magnetic roller, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.
2. Applicant's election with traverse of the restriction in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the magnetic roller structure claimed can not be made by using another process. This is not found persuasive because numerous methods, heat treatment and perforation, for example, can be used to make a foamed roller.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9-10, the specific parameters intended by “substantially equivalent” and “same sized roller” are not clearly defined.

Art Unit: 2832

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ochiai et al. [US 5,565,966] in view of Okada et al. [US 5,655,197].

Regarding claims 1-4, Ochiai et al. discloses a magnetic roller [40] formed of a material of at least 50-90% ferrite magnetic power resin [column 5, lines 12-25].

Ochiai et al. disclose the instant claimed invention except for: the roller resin being foamed.

Okada et al. disclose a roller [24] being formed of a foamed resin.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a foamed resin for the roller of Ochiai et al., as suggested by Okada et al., for the purpose of improving the application of toner in an developing device.

Regarding claim 8, Ochiai et al. discloses the use of carbon filler in the binder [column 5, line 17].

Art Unit: 2832

Regarding claims 9-10, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, the specific ratio of filler and resin would have been an obvious design consideration based on the specific operating environment.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the first embodiment of Ochiai et al. as applied to claims 1-4 above, and further in view of the second embodiment of Ochiai et al.

The first embodiment of Ochiai et al. disclose the instant claimed invention except for: the use of Nylon in the resin.

Regarding claims 5-6, Ochiai et al. discloses the use of nylon-6 [column 7, lines 53-column 8, lines 1-2] used in the resin.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use nylon in the resin of the first embodiment of Ochiai et al., as suggested by the second embodiment of Ochiai et al., for the purpose of improving strength.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ochiai et al., as modified, as applied to claims 1-2 above, and further in view of Lee et al. [US 5,019,796].

Ochiai et al., as modified, disclose the instant claimed invention except for: the filler being strontium.

Lee et al. discloses a magnetic roller using strontium.

Art Unit: 2832

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use strontium for the magnetic filler of Ochiai et al., as modified, as suggested by Lee et al., for the purpose of improving magnetic coercivity.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lincoln Donovan whose telephone number is (703) 308-3111.

The fax number for this Group is (703)-872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1782.

LDD

December 28, 2002


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100